

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

In Re Application of: Confirmation Number: 1974

Moore, Mark Justin Group Art Unit: 2194

Serial No.: 10/642,309 Examiner: Wu, Qing Yuan

Filed: August 18, 2003 Docket No.: 060707-1330

For: **Operating System for Executing Computer Software Applications**

**THIRD RENEWED PETITION UNDER 37 C.F.R. § 1.47(b)**

Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The Decision on Second Renewed Petition mailed November 22, 2010 indicates that the Petition submitted pursuant to 37 C.F.R. §1.183 is being held in abeyance to provide Petitioner an opportunity to respond to the decision. On page 4 of the Decision on Second Renewed Petition, the Decision indicates that on the third renewed petition, Petitioner should include a statement of facts from the agent of the private investigation service firm used by Petitioner to locate the inventor. Below is a restatement of the facts as submitted in the Second Renewed Petition, with accompanying declarations (Exhibits A, B) from the individuals who participated in the search for Mr. Mark Justin Moore and who have firsthand knowledge of the search effort.

In order to preserve proprietary interest in the above listed application, Petitioner hereby petitions to accept the filing of U.S. utility application, having serial no. 10/642,309, filed on August 18, 2003, said filing made on behalf of the sole inventor, Mark Justin Moore. At the time of filing, Mr. Moore executed a declaration, which was

found to be defective by the U.S. Patent and Trademark Office (USPTO). This is a third renewed petition under 37 C.F.R. §1.47 to the USPTO to accept the filing of the above-referenced application on behalf of an inventor who cannot be found or reached after diligent effort.

### **STATEMENT OF FACTS**

1. On August 18, 2004, a Declaration signed by the sole inventor, Mr. Moore, was submitted to the USPTO in response to a Notice to File Missing Parts.
2. In the first non-final Office Action dated July 2, 2007, the Declaration was rejected for being defective. Specifically, the declaration stated that the inventor believed that he was the original and sole inventor and did not include the term "first."
3. Despite Applicant's arguments regarding the sufficiency of the executed Declaration, the USPTO was unwilling to accept the Declaration. Since filing of the Declaration, Mr. Moore ceased his employment with the assignee of the present application and has been unreachable, as indicated in the previously-submitted petitions.
4. On November 23, 2009, a Petition under 37 C.F.R. §1.47 To Accept Filing of Application Made on Behalf of an Inventor Who Cannot be Found or Reach After Diligent Effort was submitted. As set forth in that petition, the present application was filed with a Declaration on August 18, 2003. At that time, the sole inventor Mr. Moore was employed by Globespan Virata and the present application was assigned accordingly. Mr. Moore was employed by Globespan Virata until December 10, 2002. Two years later, Conexant Systems, Inc. and Globespan Virata merged and the present application was assigned to Brooktree Broadband Holding, Inc., which is a wholly owned subsidiary of Conexant Systems, Inc. The Assignee's records show

a last known address for Mr. Moore as 7 George Street, Cambridge, CB 4 1AL, UK. Petitioner had attempted to locate Mr. Moore to execute a new declaration. More specifically, Patricia Dailey (Conexant employee at the time of filing) sent an e-mail to Mr. Moore on October 30, 2008 requesting his signature on the new Declaration. When Ms. Dailey did not receive a response she sent an e-mail on February 10, 2009 to the general mail box for the company Mr. Moore was believed to be employed by. After still not receiving a response to this e-mail, an e-mail was sent to Mr. Moore on October 23, 2009 requesting his signature. An e-mail was sent to Brian Knight and Martin Jackson (Mr. Moore's co-workers while Mr. Moore worked at the Assignee) on October 23, 2009 requesting Mr. Moore's current contact information. On October 26, 2009 Brian Knight replied via e-mail with the same contact information previously used to trying to locate Mr. Moore. At this time, multiple Internet searches were conducted to try and locate Mr. Moore with three telephone numbers being found. On three separate occasions, attempts were made to contact Mr. Moore at each of the numbers provided by the search with no success.

5. On January 29, 2010, a Decision on Petition was issued whereby the Petition was dismissed as the Petitioner's activities did not constitute diligent effort in trying to locate Mr. Moore.
6. On April 29, 2010, a Renewed Petition under 37 C.F.R. §1.47 was filed by Petitioner. Further efforts had been made to locate and contact Mr. Moore. As set forth in the Petition, on at least four separate occasions, attempts were made to contact Mr. Moore at certain telephone numbers with no success. Additionally, on multiple

occasions, attempts were made to contact the company (Alquanto) at which Mr. Moore was believed to be employed with the assistance of a Spanish law firm. Again, these efforts were unsuccessful.

7. On July 20, 2010, a Decision on Petition was issued whereby the Petition was again dismissed. The Decision maintained that the Petitioner's efforts did not constitute diligent effort in trying to locate Mr. Moore. Specifically, the Decision indicated that the additional step of mailing a letter to the non-signing inventor on February 12, 2010, coupled with the prior efforts, still did not constitute diligent effort in locating Mr. Moore.
8. On July 20, 2010, an Ex Parte Quayle Action was issued by the USPTO indicating that claims 1-4, 7-21, and 24-34 are allowed. The Office Action further indicated that the application is in condition for allowance except for the defective declaration. (Ex Parte Quayle Action, page 4).
9. Prior to the submission of the Renewed Petition submitted on April 29, 2010 and subsequent to the Decision on Petition mailed July 20, 2010, a number of discussions have been conducted with the assigned petitions attorney, Mr. Paul Shanoski. While Petitioner greatly appreciates the time spent by Mr. Shanoski in discussing this matter, Mr. Shanoski has not been able to provide Petitioner with specific guidance on what activities would rise to the level of diligent effort. While Petitioner appreciates that each case is fact-specific and is considered on a case-by-case basis, Petitioner has been put in a difficult position of not knowing what efforts Mr. Shanoski would find acceptable. During various telephone discussions with Mr. Shanoski, Mr. Shanoski has indicated that the additional activities described by

Petitioner are insufficient. Yet, Mr. Shanoski has not been able to provide Petitioner with guidance on what actions to take other than the suggestion to engage a private investigator. Upon further discussions with Mr. Shanoski, Petitioner agreed to invest more time and money into hiring a private investigator to help locate Mr. Moore. To date, numerous hours and resources have been spent trying to contact Mr. Moore.

*The summary below (10.-13.) is supported by the attached declarations of Mr. Michael Green (Exhibit A) and Mr. Vincent Johnson (Exhibit B), both of whom participated in the search effort for Mr. Moore.*

10. On August 18, 2010, the firm Amsel & Company ("Amsel & Co.") was hired by Petitioner to locate Mr. Moore. Amsel & Co. provides investigative services and focuses on the area of intellectual property. An interim report was sent by Amsel & Co. on September 2, 2010. Based on Mr. Moore's listed citizenship (UK) and address provided on the originally submitted declaration, the firm was able to identify a property address on George Street, Cambridge CB4 1AL in the United Kingdom for Mr. Moore. This search result was based in part on a search of the National Voters Roll database and other databases. Initial attempts to contact Mr. Moore at that address were unsuccessful. A recommendation was made by Amsel & Co. to conduct an in-person visit to the address. This, however, would require additional cost on the part of the Petitioner. Petitioner authorized the additional expense, and an agent of Amsel & Co. was then sent to try and make contact with Mr. Moore in person.

11. Multiple visits were made to the property with no success. Finally, On September 14, 2010, an individual who was renting the property from Mr. Moore answered the

door. Upon further discussion, the agent was informed that Mr. Moore had been out of the country but had just arrived back in the country. Later that evening, contact was made with Mr. Moore over the telephone by an agent of Amsel & Co. The following is a summary of the telephone discussion between Mr. Moore and an agent of Amsel & Co. on September 14, 2010:

- a. Mr. Moore first indicated that he had just flown in from Kyoto, Japan and would be flying back out of the country to Spain on September 15, 2010.
- b. Mr. Moore would then be in Spain for only a week. After that, he would be traveling to Italy, where he would be for 2 weeks.
- c. After that, Mr. Moore indicated that he would continue his work travels and would not return to the United Kingdom until sometime next year.
- d. When asked, Mr. Moore indicated that he could not be reached via a mobile telephone and that the only way to reach him would be by an e-mail address, which he provided.
- e. Mr. Moore's final remark during the telephone conversation was that "*I will only be stable communication wise next week with regard to e-mails so this will be a good time for them to send me a communication.*"

12. Petitioners note that the e-mail address provided by Mr. Moore during the telephone call on September 14, 2010 was the same address Petitioner had utilized during earlier search efforts to no success.

13. On September 15, 2010, Amsel & Co. communicated the details of the telephone call, as set forth above. Since September 14, 2010, Petitioner has tried to contact Mr. Moore on three occasions using the e-mail address provided by Mr. Moore:

September 16, 2010; September 22, 2010; and on October 8, 2010. Petitioner has not received a response from Mr. Moore. Among other documents, a declaration has been sent to the e-mail address.

14. In view of the new efforts by Petitioner since the last petition, coupled with prior efforts, Petitioner hereby renews the petition previously made to file the application on behalf of Mr. Moore, who is the sole inventor of the application. From the facts, as they now exist, Petitioner respectfully submits that this petition may be treated as either (1) a petition to file on behalf of an inventor who refuses to sign, or (2) a petition to file on behalf of an inventor who cannot be found. With regard to the first type, Petitioner respectfully submits that the actions (*i.e.*, the lack of response within the narrow window of availability provided) on the part of Mr. Moore since the telephone call on September 14, 2010 constitutes a constructive refusal to sign. Mr. Moore clearly indicated that he would “*. . . only be stable communication wise next week with regard to e-mails so this will be a good time for them to send me a communication.*” This corresponds to approximately the dates spanning September 15, 2010 to September 22, 2010. Mr. Moore indicated that this would be the best time to reach him. E-mails sent within (and beyond) this window of availability have not been responded to. Mr. Moore also indicated that he would not be reachable via mobile communications or other forms of communication. Given the transient nature of Mr. Moore’s travel status and the limited channel of communication, Petitioner submits that these actions constitute a refusal to sign.

In the alternative, Mr. Moore can no longer be found. Mr. Moore did not leave any other way to reach him other than via e-mail. Furthermore, he indicated that he

would be traveling to various countries, making it difficult for Petitioner to locate Mr. Moore. Therefore, under these circumstances, reasonable efforts have been made to locate Mr. Moore, but at this time, he cannot be effectively located so as to be presented with the declaration. Therefore, Petitioner submits that diligent (albeit unsuccessful) effort has been made to locate Mr. Moore. Mr. Moore has been presented with the declaration but constructively refused to sign it by failing to respond within the very narrow window of time in which he indicated that he would be available.

15. Accordingly, Petitioner hereby petitions the USPTO, pursuant to 37 C.F.R. §1.47, to allow the assignee, by operation of law, to file this application on Mr. Moore's behalf. Petitioner has clearly illustrated a diligent attempt to locate the sole inventor, Mr. Moore. Additionally, to preserve the rights of the assignee (Conexant Systems, Inc.) and to prevent irreparable damage to the assignee, Petitioner respectfully requests a grant of this petition.

16. No additional fee is deemed to be payable in connection with this Petition other than those fees included with this Petition. Should any additional fee be required, you are hereby authorized to charge any such additional fee to Deposit Account No. 20-0778.

Respectfully submitted,

/ Jeffrey Hsu /

**Jeffrey Hsu**  
**Reg. No. 63,063**

**THOMAS, KAYDEN,  
HORSTEMEYER & RISLEY, L.L.P.**  
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(770) 933-9500

**EXHIBIT A**

**IN THE UNITED STATES PATENT & TRADEMARK OFFICE**

In Re Application of: Confirmation Number: 1974

Moore, Mark Justin Group Art Unit: 2194

Serial No.: 10/642,309 Examiner: Wu, Qing Yuan

Filed: August 18, 2003 Docket No.: 060707-1330

For: **Operating System for Executing Computer Software Applications**

**DECLARATION IN SUPPORT OF 3<sup>RD</sup> RENEWED PETITION**  
**UNDER 37 C.F.R. § 1.47**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

I, Jeffrey Michael Green, declare as follows:

1. I am a partner at Amsel & Co., a firm that provides investigative services and that specializes in intellectual property rights. I joined Amsel & Co. as a partner in 1996.
2. I am a Member of the Institute of Professional Investigators, a Member of the Association of British Investigators, a Member of the World Association of Detectives and an Associate Member of the Institute of Legal Executives.
3. On August 18, 2010, my firm was commissioned by Petitioner to locate Mr. Mark Justin Moore. We received instructions from Jeffrey Hsu, an attorney at the law firm Thomas, Kayden, Horstemeyer & Risley, LLP.
4. On September 2, 2010, I provided an interim report to Mr. Hsu. Below is a summary of my search efforts:

## EXHIBIT A

- a. **Corporate enquiries:** A search of Companies House Officers Register revealed two listings for an individual bearing the name Mark Moore with a Post Code of CB4. Both those listings were examined and found to contain the same entries being in respect of Mark Moore of 7 George Street, Cambridge CB4 1AL with a date of birth of the 22nd March 1967. The entries were the appointment as Secretary of VEEBEAM LIMITED on the 17th September 2002 from which post he resigned on the 8<sup>th</sup> November 2002 and an appointment as a Director of the same company on the 17th September from which post he resigned on the 11th November 2008. VEEBEAM LIMITED was incorporated on the 17th November 2002 in the name of ARTIMI LIMITED and changed its name on the 14th April 2009 to STACCATO COMMUNICATIONS LIMITED and changed its name again on the 30th March 2010 to its current title. The Registered Office of the company is given as Betjeman House, 104 Hills Road Cambridge CB2 1QL.
- b. **National Voters Roll searches:** My firm conducted a search of the National Voters Roll database revealed listings for 45 individuals bearing the name MARK J MOORE. Seven of those listings were in respect of current registrations of individuals within the appropriate age group (40 to 44 years of age). None of those listing were in respect of address local to Cambridge. However it was noted there was a listing for an individual within an age grouping of 30-34 at an address of 234 Chieftain Way Cambridge CB4 2EY. A further search was made of the National Voters

Roll database on this occasion by the property address of George Street, Cambridge CB4 1AL. This search revealed a listing for two individuals at number 7, being Marco Madella who was recorded as a voter at the address between 2001 and 2002 and Mark Moore also between 2001 and 2002. I noted in my report that Data Protection Legislation does enable a Voter to elect not to have his name disclosed. I noted in my report that it is therefore possible that Mark Moore continues to reside at 7 George Street, Cambridge CB4 1AL.

- c. **Telephone listings:** My firm also conducted a search of the British Telecom Directory. The enquiry service did not initially reveal any listing for an individual bearing the name Moore at the address 7 George Street, Cambridge CB4 1AL. However a subsequent search revealed a telephone listing of 01223571700.
- d. **Social Networking databases:** Searches of Social Networking Databases did not reveal any reference to a Mark Justin Moore or Mark Moore overtly connected to the subject of this enquiry. However a page was found on the Facebook web site for Marco Madella. The information he discloses is sufficient to corroborate that he is one and the same Marco Madella apparently resident with Mark Moore at 7 George Street, Cambridge CB4 1AL between 2001 and 2002. Marco Madella discloses his apparent employment address and is a possible point of contact for further information. However it should be noted that he is now resident in Australia and he does not list Mark Moore among one of his "friends".

**EXHIBIT A**

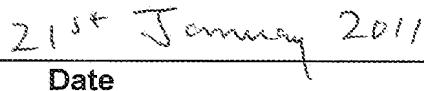
- e. **H M Land Registry search:** My firm also conducted a search of the Land Registry database in respect of the property 7 George Street, Cambridge CB4 1AL. This search revealed that Mark Justin Moore who gives his address as 7 George Street, Cambridge CB4 1AL is the current registered Proprietor of the property, having purchased the same on or about the 13th October 1999. There is no Mortgage or other Legal Charge registered on the property.
5. Based on my search results, I made a recommendation to Jeffrey Hsu that an in-person visit to the address be conducted. This, however, would require additional cost. Mr. Hsu authorized the additional expense, and I asked a colleague, Mr. Vincent Johnson, to attempt and make contact with Mr. Moore at the address. We sent Mr. Johnson on our behalf because of the long distance between Mr. Moore's last known address and my firm.
6. Upon Mr. Johnson's on-site visit on September 14, 2010, and his telephone discussion with Mr. Moore took on September 15, 2010, Mr. Johnson provided me with a summary. I then communicated Mr. Johnson's findings to Mr. Hsu on September 15, 2010.

**EXHIBIT A**

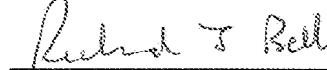
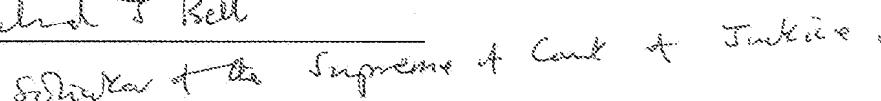
**DECLARATION**

I hereby declare that all statements made herein are of my own knowledge are true and that all statements are made on information and belief and are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

  
\_\_\_\_\_  
**Jeffrey Michael Green**

  
\_\_\_\_\_  
**Date**

The above Declaration was made before me

  
\_\_\_\_\_  
**Richard T Bell**  
  
\_\_\_\_\_  
**Solicitor & the Supreme of Court & Justice**

**HAWORTH HOLT BELL LIMITED**  
Grosvenor House  
45 The Downs  
Altrincham  
Cheshire WA14 2QG  
No: England 503 8210

**EXHIBIT B**

**IN THE UNITED STATES PATENT & TRADEMARK OFFICE**

In Re Application of:

Moore, Mark Justin

Confirmation Number: 1974

Group Art Unit: 2194

Serial No.: 10/642,309

Examiner: Wu, Qing Yuan

Filed: August 18, 2003

Docket No.: 060707-1330

For: **Operating System for Executing Computer Software Applications**

**DECLARATION IN SUPPORT OF 3<sup>RD</sup> RENEWED PETITION**  
**UNDER 37 C.F.R. § 1.47**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

I, Vincent Johnson, declare as follows:

1. I am the Proprietor of the Cambridge Detective Agency of Sheraton House, Castle Park, Cambridge CB3 0AX.
2. I am a full member of The Association of British Investigators, the Institute of Professional Investigators and the World Association of Professional Investigators.
3. At the request of Michael Green of Amsel & Co., I conducted an on-site visit to the last known address of Mark Justin Moore (7 George Street Cambridge CB4 1AL).
4. The on-site visit took place on September 14, 2010, and my telephone discussion with Mr. Moore took place on September 15, 2010. Below is a

**EXHIBIT B**

summary of my visit to Mr. Moore's residence, which I conveyed to Mr. Green:

- a. The property located at 7 George Street Cambridge CB4 1AL is a terraced style 2/3 bedroomed Victorian property situated in Cambridge. Initial local inquiries with neighbors proved fruitless. Only one person of those spoken to thought the property was rented out. Nothing appeared to be known in the locality of Mark Justin Moore. Regular visits were made to the property, which were finally rewarded on the evening of the 14th September 2010 when the door was opened by a female of apparent Italian origin, who stated she was visiting a tenant called "Marco." She also informed me that Mark Moore was the owner of the house and that he had literally just flown into the country and was due to fly out the next day. Mark Moore was apparently not at the property at the time of the call. Contact details were given to the female with an earnest request she use her best endeavors to have the subject make contact.
- b. Later that evening, a male who identified himself as Mark Justin Moore made telephone contact from the telephone number 01223 464464. He stated it would not be possible to return his call as there was a "switchboard." I informed the subject of the purpose of the inquiry. Mr. Moore appeared quite amenable and did not appear adverse to assisting with the problem.

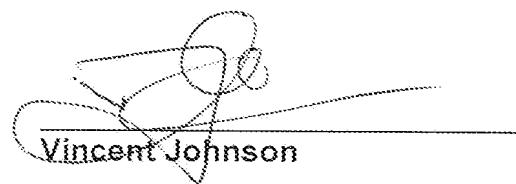
**EXHIBIT B**

- c. The subject stated that he had just flown in from Kyoto, was flying to Spain on the 15th September 2010 and that after would be in Spain for a week from where he was travelling on to Italy, where he would be for 2 weeks. After that, he would continue his work travels and will not return to the United Kingdom until sometime next year.
- d. Mr. Moore stated to me that his mobile telephone was of no use and further stated the only safe way to get a message/document to him would be by e-mail at mark.moore@alquanto.com.
- e. Mr. Moore's final comment to me was to the effect that "*I will only be stable communication wise next week with regard to e-mails so this will be a good time for them to send me a communication.*"

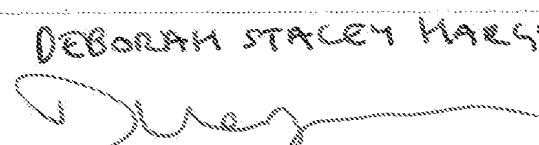
**EXHIBIT B**

**DECLARATION**

I hereby declare that all statements made herein are of my own knowledge are true and that all statements are made on information and belief and are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

  
Vincent Johnson

26/1/11  
Date 26th January 2011

  
Deborah Stacey Hargreaves

26/1/11 26th January 2011

Solicitor/Commissioner for Oaths  
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CB8 8AR